

REMARKS

Claims 1-20 are pending in this application. Claims 1, 2, 5, 7-11, 14, and 16-20 were rejected. Claims 3, 4, 6, 12, 13 and 15 were objected to as being dependent upon a rejected base claim.

Claim Rejections – 35 U.S.C. § 103

Claims 1, 2, 5, 7-11, 14, and 16-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Buckland et al. in view of ACPI.

1. Lack of Motivation

An assertion of obviousness in view of multiple references does not support a *prima facie* case of obviousness unless a motivation, suggestion or teaching is identified of the specific combination that was made by the applicants. *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). The Examiner asserts that a motivation exists because “Buckland explicitly states the need to isolate and remove a device that produces a first error signal without shutting down power to the entire system.” Even if Buckland taught such a need, the specific combination taught claimed by applicants is not motivated thereby. As the Examiner stated, Buckland does not teach an operating system, including device drivers, capable of configuring communications between one or more applications and the bus. There is no motivation in Buckland for the addition of features related to configuring communications between applications and a bus using device drivers.

The purported motivation is also deficient because Buckland explicitly teaches that there is no need to include elements from other references to isolate and remove a device, because the disclosed embodiments meet that need. “FIG. 7 shows the components of the

present invention, which allow adapter cards to be installed, removed or replaced, without the need to power off the entire system.” Buckland at col. 6, lines 45-47. “The bridge chip 104 is then used to isolate the secondary bus 103 and slot 106 from the remainder of I/O bus 102.” Buckland at col. 6, lines 65-67. To the extent Buckland teaches a need to isolate and remove a device, it does not motivate any combination with another reference (such as the ACPI) because it also teaches that those needs are met by the embodiments disclosed in Buckland. In the absence of a motivation or suggestion to combine, the obviousness rejection should be withdrawn. MPEP § 2143.01. Applicants respectfully request withdrawal of the obviousness rejections of claims 1, 2, 5, 7-11, 14, and 16-20.

2. Buckland Teaches Away from the Subject Matter

In the abstract of the invention, Buckland teaches that “[t]he device issuing the error signal is then isolated and error recovery techniques, (or re-initialization) are implemented only on the device with the error condition.” The Examiner has combined Buckland with the ACPI, asserting that the generation of a hot-eject signal by the BIOS would have been added in such a combination. The generation of a hot-eject signal in response to an error signal would conflict with Buckland’s stated intention to implement error recovery techniques. An error recovery technique cannot be implemented on the device if the device is ejected. Buckland, therefore, teaches away from adding a hot-eject signal generation feature. Prior art cannot be combined in a manner that defeats its purpose. *In re Hedges*, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986). Applicants respectfully request withdrawal of the obviousness rejections of claims 1, 2, 5, 7-11, 14, and 16-20 because the references teach away from the asserted combination.

SUMMARY


In light of the above remarks Applicants respectfully submit that the application is now in condition for allowance and early notice of the same is earnestly solicited. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile or electronic mail, as below.

Applicants believe no fees are due. However, should the Commissioner deem any fees are due, including any fees for additional extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and further authorize the Commissioner to debit any additional fees due, or to credit any overpayments, to Baker Botts L.L.P. Deposit Account Number 02-0383, Order Number 016295.0763.

Respectfully submitted,

Baker Botts L.L.P.

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By: 
Michael A. Hawes
Registration No. 38,487
ATTORNEY FOR APPLICANTS

Correspondence Address:

Baker Botts L.L.P. (023640)
One Shell Plaza
910 Louisiana Street
Houston, Texas 77002-4995
Telephone: 713.229.1750
Facsimile: 713.229.7750
EMail: Michael.Hawes@bakerbotts.com